

REMARKS

In the Office Action, the Examiner rejected claims 1–24 under 35 U.S.C. § 103(a) over U.S. Patent 5,570,291 (“*Dudle*”) in view of Applicants’ disclosure. Applicants have canceled claims 2, 9, and 16, without prejudice or disclaimer of the subject matter contained therein. In view of the cancellation of those claims, Applicants deem their rejection moot and do not address their rejection.

Information Disclosure Statement

On March 8, 2002, Applicants submitted a Form PTO 1449 identifying references for consideration by the Examiner. Although the May 4, 2004 Office Action included a returned Form PTO 1449 that had been submitted February 26, 2004, the May 4, 2004 Office Action did not include the March 8, 2002 Form PTO 1449. Applicants request that the next communication from the Office include a copy of the Form PTO 1449 previously provided with an indication that the cited references have been considered.

Amendment

Applicants cancel claims 2, 9, and 16, without prejudice or disclaimer of the subject matter contained therein. Applicants also amend claims 1, 3–5, 8, 10–12, 15, 17–19, 21, and 24 as indicated in the listing of claims to more appropriate claim Applicants’ invention and correct a typographical error. Applicants also add new claims 25–32. Claims 1, 3–8, 10–15, and 17–32 are currently pending.

Rejection under § 103(a)

To establish a *prima facie* case of obviousness under §103(a), each of three requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine references or modify a reference. (MPEP § 2143 (8th ed.

Rev. Feb. 2003).) Second, there must be a reasonable expectation of success. (*Id.*) Moreover, both of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” (*Id.*) Third, the reference or references, taken alone or in combination, must disclose or suggest every element recited in the claims. (MPEP §2143.03.)

Because the Examiner fails to present a prima facie basis for rejecting the pending claims, Applicants traverse their rejection. If the Examiner maintains his rejection of the claims, Applicants request that the Examiner identify with sufficient specificity which portions of *Dudle* he is applying to each claim element.

According to the Examiner, *Dudle* discloses a custom product estimating and order processing system, which uses a computer system. The system includes a corporate office 16, a sales site 12, and a plant 14. (*Dudle*, FIG. 1.) The system also includes prompting a buyer to input a specification of a product, extracting a product which meets the specification from a database, and providing an estimate to the buyer if a condition for manufacturing the product is satisfied. (*Id.*, col. 3, ll. 59–64, col. 4, ll. 8–14.) Also according to the Examiner, *Dudle* does not:

teach that the product manufactured is an electronic product, specifically a semiconductor. However, Applicant discloses at page 1 of the specification that the ordering and manufacturing of custom electronic products, specifically semiconductors consumes much time and involves considerable costs. . . . Thus it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system and method of *Dudle* at al. in order to facilitate the custom ordering of electronic products, as disclosed by Applicant in order to reduce the time and cost associate with such an order.

(May 4, 2004 Office Action at 2–3.)

Without agreeing with Examiner's characterization of *Dudle*, Applicants note that *Dudle* fails to teach or suggest simulating a condition for manufacturing. Moreover, no other reference teaches or suggests simulating a condition for manufacturing or would motivate one to modify a reference.

There is no disclosure or suggestion in *Dudle* of at least

- “*simulating a condition for manufacturing the electronic product* including at least performance before outputting information of the electronic product,” or
- “*providing the expected buyer with the condition for manufacturing the electronic product to prompt the expected buyer to answer* if the condition for manufacturing the electronic product is satisfied or not,”

as recited in claim 1 (emphasis added). The Examiner cites no other reference to compensate for this difference. Absent a disclosure of suggestion of each element, or a motivation to modify a reference, there can be no basis for rejecting claim as obvious. Further, the MPEP makes clear that requirements that there is a motivation to combine or modify a reference and that there is an expectation of success “must ‘be found in the prior art, and not based on applicant’s disclosure.’” (MPEP § 2143.) Yet the Examiner cites nothing from the prior art for a motivation to combine or modify *Dudle*. At any rate, combination of *Dudle* with the related art described in Applicants’ disclosure fails to teach or suggest each claim element, which prevents an obviousness rejection. Thus claim 1 is allowable, and Applicants request that the withdrawal of its rejection and its timely allowance. Applicants further request the withdrawal of the rejection of claims 3.

6, 7, and 22, which are likewise allowable at least because of their dependence from allowable claim 1.

For at least the reasons given above with respect to claim 1, *Dudle* in combination with the related art described in Applicants' disclosure also fails to teach or suggest:

- “*wherein the first device causes to simulate a condition for manufacturing the electronic product including at least performance after causing to extract the electronic product from the database, and provides the applicant with the condition for manufacturing the electronic product to prompt the applicant to answer if the condition for manufacturing the electronic product is satisfied or not,*”

as recited in claim 8 (emphasis added). This is nowhere taught or suggested by *Dudle*, and no reference compensates for this deficiency of *Dudle*. At least because the references fail in combination to teach or suggest each claim element and because there is no motivation to modify *Dudle*, claim 8 should be allowed over the references. Claims 10, 13, 14, and 23 should likewise be allowed at least because of their dependence from allowable claim 8.

Dudle also fails to disclose or suggest, at least:

- “*a fourth program code recorded on the recording medium and configured to assign the computer system a command for simulating a condition for manufacturing the electronic product including at least performance before outputting the information of the electronic product,*”

as recited in claim 15 (emphasis added). No other reference compensates for this deficiency. For this reason and the reasons given above with respect to claim 1, claim 15 should be allowed as should claims 17, 20, and 24, which depends from allowable claim 15.

Although *Dudle* discloses a corporate office sending a production order to a plant (Dudle, Figure 4B), *Dudle* fails to teach or suggest, at least:

- “prompting the manufacturer to provide an estimated result of the electronic product,” or
- “determining if an order of the electronic product to the manufacturer should be placed or not based on the estimated result which is received from the manufacturer,”

as recited in claim 4. No reference compensates for this deficiency and there is no motivation to modify *Dudle*. Thus claim 4 should be allowed, as should its dependent claim—claim 5—since there no prima facie basis for rejecting these claims as obvious.

Claim 18, although different in scope from claim 4, similarly recites,

- “a fourth program code recorded on the recording medium and configured to assign the computer system *a command for prompting the manufacturer to provide an estimated result of the electronic product,*” and
- “a fifth program code recorded on the recording medium and configured to assign the computer system a command for determining if an order of the electronic product to the manufacturer should be placed or not *based on the estimated result which is received from the manufacturer,* and

placing the order of the electronic product to the manufacturer if the determination indicates that the order of the electronic product to the manufacturer should be placed.” (emphasis added)

Dudle, however, also fails to teach or suggest at least these elements of claim 18. No other reference compensates for this deficiency and there is no motivation to modify *Dudle*. Thus claim 18 should be allowed as should claim 19, which depends from allowable claim 18.

Dudle also fails to teach or suggest at least:

- “wherein the first device *prompts the manufacturers to answer if the manufacturers can receive an order of the electronic product or not, determines whether the order of the electronic product to the manufacturers should be placed or not based on the answer* which is received from the manufacturers, and *places the order of the electronic product to one of the manufacturers if the determination indicates that the order of the electronic product to the one of manufacturers should be placed,*”

as recited in claim 11. No other reference compensates for this deficiency and there is no motivation to modify the reference. Thus claim 11 should be allowed. Claim 12 should also be allowed at least because of its dependence from allowable claim 11.

Dudle also fails to teach or suggest at least:

- “*transmitting a retrieval program for retrieving an electronic product which meets a specification of the electronic product an expected buyer of the electronic product wants to buy to a terminal to prompt the terminal to start*

the retrieval program and transmit data which indicates a result of the retrieval including the specification of the electronic product," as recited in claim 21 (emphasis added).

Although *Dudle* may disclose that a program is previously stored in computers 62 and 64 of the sales site (*id.*, col. 8, ll. 44–46), this is not the same as the recited claim element. Moreover, no other reference compensates for *Dudle*'s deficiency and there is not motivation to modify it. Claim 21 should, therefore, be allowed.

New claims

By this amendment, Applicants add new claims 25–32. Each new claim depends from an allowable independent claim, as demonstrated above. Therefore, each of claims 25–32 should likewise be allowable.


In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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